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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

HOLOGIC, INC., CYTYC CORPORATION,
and HOLOGIC L.P.,

Plaintiffs,

vs.

SENORX, INC.,

Defendant.

AND RELATED COUNTERCLAIMS.

Case No. C08 00133 RMW (RS)

**PLAINTIFFS' NOTICE OF MOTION AND
MOTION TO COMPEL RESPONSES TO
CERTAIN INTERROGATORIES**

Date: No hearing requested
Judge: Hon. Richard Seeborg

1 **NOTICE OF MOTION AND MOTION TO COMPEL**

2 Please take notice that Plaintiffs Hologic, Inc., Cytac Corporation, and Hologic L.P.
 3 (collectively, "Hologic") will move and do hereby move the Court for an order compelling Defendant
 4 SenoRx, Inc. ("SenoRx") to fully and completely respond immediately to Interrogatories Nos. 1-3
 5 served by Hologic on March 4, 2008. This Motion is based on the accompanying Memorandum of
 6 Points and Authorities, the Declaration of Katharine L. Altemus, the attached exhibits, and the oral
 7 arguments of counsel should the Court order a hearing on this matter. As explained in the
 8 accompanying Motion to Shorten Time, Hologic is asking that the Court dispense with the requirement
 9 of a hearing on this matter.

10 **STATEMENT OF RELIEF**

11 Hologic requests an order, pursuant to Fed. R. Civ. P. 37(a)(3), as well as Civil Local Rules 37-
 12 1 and 37-2, compelling SenoRx to immediately respond fully and completely to Interrogatories Nos. 1-
 13 3 which were served on March 4, 2008. Ex. A¹.

14 **MEMORANDUM OF POINTS AND AUTHORITIES**

15 **I. INTRODUCTION**

16 Even though it agreed with Hologic to expedite discovery for the limited purpose of the
 17 upcoming preliminary injunction hearing, SenoRx now attempts to deny Hologic reciprocal timely
 18 discovery that Hologic needs in order to prepare, within the Court's schedule, its reply to SenoRx's
 19 arguments against issuance of a preliminary injunction in this case. Specifically, SenoRx has refused
 20 to answer interrogatories going directly to the factors to be considered by this Court when adjudicating
 21 the preliminary injunction motion, with the result, *inter alia*, that Hologic will be unable: (1) to gather
 22 essential information on SenoRx's accused product and business; (2) to adequately prepare for
 23 deposition discovery prior to filing its Reply, and (3) to ensure that SenoRx has responded fully to
 24
 25

26 ¹ Unless otherwise noted, all cited exhibits refer to exhibits attached to the Declaration of Katharine L.
 27 Altemus ("Altemus Decl.") In Support of Plaintiffs' Motion To Compel Responses To Certain
 28 Interrogatories.

Hologic's limited document requests. Hologic therefore asks this Court to order that SenoRx immediately respond fully to Hologic's Interrogatories Nos. 1-3.

II. STATEMENT OF FACTS

On February 6, 2008, Hologic filed its Motion For Preliminary Injunction. At a case management conference on February 29, 2008, the Court scheduled the hearing for that preliminary injunction motion on April 21, 2008, and ordered that SenoRx file its Opposition to the Motion for Preliminary Injunction on or before March 28, 2008 and that Hologic file its Reply on or before April 7, 2008. While at the courthouse for that conference, counsel for the parties conferred about discovery matters, and agreed to provide substantive responses to limited discovery on an expedited basis. See Ex. B. Specifically, counsel agreed to respond to Interrogatories within 10 days of service, and to produce documents responsive to Requests for Production within 10 days or as soon as possible thereafter. *Id.*

On March 4, 2008, Hologic served its First Set of Interrogatories (Nos. 1-4) on SenoRx directed particularly to information known only to SenoRx, *e.g.*, any purported harm it would suffer as a result of an injunction, its financial situation, any purported public health benefits uniquely provided by its products, etc. With that information in hand, Hologic would be in a position to narrowly tailor its corporate deposition notice to only those issues raised by SenoRx and, more importantly, to prepare fully for and take that deposition with sufficient time thereafter to use and rely upon the sworn testimony in the preparation of its April 7, 2008 Reply Memorandum. Such interrogatories would also allow Hologic to ensure that any document production issues would be resolved prior to the hearing. Ex. A.

On March 14, 2008, SenoRx served its Objections and Responses to Plaintiffs' First Set of Interrogatories (Nos. 1-4). Ex. C. The specific Interrogatories (Nos. 1-3) and SenoRx's (non-) Responses thereto at issue in this motion are reproduced in relevant part below.

• INTERROGATORY NO. 1:

Describe in detail any harm that SenoRx contends it will suffer should a preliminary injunction prohibiting the manufacture, use, sale, or offer for sale of the Contura Multi-Lumen Balloon issue, and identify any documents upon which SenoRx will rely as evidence of that alleged harm.

RESPONSE TO INTERROGATORY NO.1:

SenoRx incorporates its General Objections as if fully set forth herein. *SenoRx objects to this interrogatory on the grounds that it is premature and conflicts with the parties' stipulated briefing schedule for response to Plaintiffs' Motion for a Preliminary Injunction, as discussed in the February 29, 2008 Case Management Conference and set forth in the parties' proposed case management order filed on March 4, 2008, and attempts to circumvent the parties' agreed schedule.*

Accordingly, the Interrogatory is overly broad and unduly burdensome. SenoRx also objects that this Interrogatory is compound. *SenoRx will set forth the harm it contends it will suffer should a preliminary injunction issue, and the support therefore, as appropriate, in its Opposition to Plaintiffs' Motion.* [emphases added.]

• **INTERROGATORY NO. 2:**

If SenoRx contends that a preliminary injunction prohibiting the manufacture, use, sale, or offer for sale of the Contura Multi-Lumen Balloon should not issue, explain the basis for that contention, including, but not limited to,

(a) the basis for any contention that claim 1 of the '142 patent or claim 36 of the '204 is invalid or unenforceable (including, but not limited to, an element-by-element comparison of any allegedly invalidating prior art to each asserted claim);

(b) the basis for any contention that SenoRx does not infringe claim 1 of the '142 patent or claim 36 of the '204 (including, but not limited to, an element-by-element comparison of how the Contura differs from each asserted claim);

(c) an identification of all documents upon which SenoRx intends to rely to support these contentions; and (d) an identification of all persons with knowledge concerning these contentions.

RESPONSE TO INTERROGATORY NO. 2:

SenoRx incorporates its General Objections as if fully set forth herein. *SenoRx objects to this interrogatory on the grounds that it is premature and conflicts with the parties' stipulated briefing schedule for response to Plaintiffs' Motion for a Preliminary Injunction, as discussed in the February 29, 2008 Case Management Conference and set forth in the parties' proposed case management order filed on March 4, 2008, and attempts to circumvent the parties' agreed schedule.* SenoRx further objects to this Interrogatory as premature in light of the timetables provided in the Patent Local Rules. SenoRx also objects that this Interrogatory is compound. SenoRx also objects that this Interrogatory is overly broad and unduly burdensome, and seeks information not relevant to the claim or defense of any party, in that it seeks the identification of "all persons" with knowledge concerning these contentions. SenoRx also objects to this Interrogatory on the grounds that it seeks information that is protected by the attorney-client privilege, the work product doctrine, or any other applicable privilege. *To the extent that SenoRx contends a preliminary injunction should not issue for reasons of invalidity, unenforceability, or non- infringement, SenoRx will set forth those contentions, and the support therefore, as appropriate, in its Opposition to Plaintiffs' Motion.* [emphases added.]

1 • **INTERROGATORY NO. 3:**

2 Describe in detail the differences between the Contura Multi-Lumen Balloon and the
3 MammoSite devices that SenoRx believes are or would be material to medical
4 professionals and/or patients, including, but not limited to, any information provided to
5 medical professionals (including current or former MammoSite users) and all bases for
6 SenoRx's assertions that

7 (a) "[c]ertain patients who are presently candidates for balloon therapy are currently
8 excluded because of the location of the lesion relative to their breast size. Our multi-
9 lumen approach offers a solution to this problem." See SenoRx May 23, 2007 press
10 release (posted at [http://www.senorx.com/siteadmin/files/SenoRAnnounces510_k_](http://www.senorx.com/siteadmin/files/SenoRAnnounces510_k_ClearanceforMulti-LumenRadiationBalloon.pdf)
11 [ClearanceforMulti-LumenRadiationBalloon.pdf](http://www.senorx.com/siteadmin/files/SenoRAnnounces510_k_ClearanceforMulti-LumenRadiationBalloon.pdf)). As part of your answer to this
12 subsection, explain in detail (i) how the Contura MLB offers a solution to patients who
13 are "currently excluded because of the location of the lesion relative to their breast
14 size," (ii) whether "the solution" discussed above is to use the Contura MLB with a
15 balloon-to-skin distance of less than 5mm; and

16 (b) "[so]me patients who are presently candidates for balloon therapy are currently
17 excluded because of the location of the lesion and their breast size. Contura's advanced
18 multilumen design may address this issue for certain patients." See SenoRx January 17,
19 2008 press release (posted at [http://www.senorx.com/siteadmin/files/SenoRxLaunches](http://www.senorx.com/siteadmin/files/SenoRxLaunchesContura.pdf)
20 [Contura.pdf](http://www.senorx.com/siteadmin/files/SenoRxLaunchesContura.pdf)). As part of your answer to this subsection, explain in detail (i) how the
21 Contura MLB may address "this issue for certain patients"; and (ii) whether the method
22 by which the Contura MLB "may address this issue for certain patients," as discussed
23 above, is to use the Contura MLB with a balloon-to skin distance of less than 5mm.

24 **RESPONSE TO INTERROGATORY NO. 3:**

25 SenoRx incorporates its General Objections as if fully set forth herein. *SenoRx*
26 *objects to this interrogatory on the grounds that it is premature and conflicts with*
27 *the parties' stipulated briefing schedule for response to Plaintiffs' Motion for a*
28 *Preliminary Injunction, as discussed in the February 29, 2008 Case Management*
Conference and set forth in the parties' proposed case management order filed on
March 4, 2008, and attempts to circumvent the parties' agreed schedule. SenoRx
also objects that this Interrogatory is compound. SenoRx also objects that its answer
to this Interrogatory may incorporate information requested from Plaintiffs in
discovery, which information has not yet been produced. SenoRx also objects that
this Interrogatory is overly broad and unduly burdensome in that it seeks information
not related to the preliminary injunction. SenoRx further objects to this Interrogatory
in that it prematurely seeks expert testimony. SenoRx also objects to this
Interrogatory on the grounds that it seeks information that is protected by the
attorney-client privilege, the work product doctrine, or any other applicable
privilege. *As relates to the preliminary injunction, SenoRx will set forth its*
contentions and the support therefore, as appropriate, in its Opposition to
Plaintiffs' Motion. [emphases added.]

1 III. ARGUMENT

2 By refusing to answer Interrogatories Nos. 1-3, SenoRx has reneged on its agreement with
3 Hologic with respect to the conduct of limited, expedited discovery. Even as it demands discovery
4 from Hologic on a timely and complete basis, SenoRx denies Hologic substantive discovery on the
5 core issues to any preliminary injunction: the likelihood of Hologic's success on the merits of its
6 lawsuit, an assessment of the harm to each party, and a fully informed evaluation of the public interest.

7 SenoRx's stated objection—that the Interrogatories are premature—lacks any merit. The
8 Interrogatories go to the limited issues to be presented and argued at the preliminary injunction
9 hearing; fundamental fairness dictates that Hologic be able to obtain reciprocal discovery from SenoRx
10 in order to adequately prepare its case for deposition and the hearing. SenoRx's recalcitrance in
11 answering these basic Interrogatories forces Hologic to sit idly while SenoRx develops its rebuttal
12 case, constrained until the last two days of March from investigating SenoRx's factual claims and
13 arguments to develop Hologic's Reply.

14 Indeed, because Hologic's Interrogatories seek relevant, discoverable information necessary for
15 Hologic to prepare adequately for deposition and the preliminary injunction hearing, Hologic is
16 entitled to answers unless the Court enters a protective order. *Oleson v. Kmart Corporation*, 175
17 F.R.D. 570, 572 (D. Kan. 1997). Despite the fact that it contends the Interrogatories are premature,
18 SenoRx has not sought a protective order.

19 SenoRx is, furthermore, certainly in possession of responsive information. In filing its Answer
20 on February 28, 2008, SenoRx alleged that its Contura Multi-Lumen Balloon does not infringe the
21 patents-in-suit. Thus, SenoRx must have had a Rule 11 basis for that assertion. There is no legitimate
22 reason to withhold the disclosure of that information. SenoRx is also clearly aware of the facts relating
23 to its allegations that SenoRx will be harmed by issuance of an injunction, since these are facts about
24 SenoRx. Hologic is entitled to SenoRx's responses to its Interrogatories, however preliminary they
25 may be. See *S.E.C. v. Brown*, 2006 WL 889367, *4 (D. Minn. Mar. 29, 2006)(granting both parties
26 leave for expedited discovery, including interrogatories, before preliminary injunction hearing); *United*
27 *Rentals v. Nardi*, 2002 WL 32503665, *1 (D. Conn. July 10, 2002)(recognizing that expedited
28

1 discovery by each party was necessary to present opposing arguments at the preliminary injunction
 2 hearing); *U.S. ex. rel. O'Connell v. Chapman University*, 245 F.R.D. 646, 649 (C.D. Cal.)(recognizing
 3 the importance and relevance of contention interrogatories to obtain factual information that, consistent
 4 with Fed. R. Civ. P. 11, must underlie filed pleadings); *Shearson Lehman Hutton, Inc. v. Lambros*, 135
 5 F.R.D. 195, 198-199 (M.D. Fla. 1990)(requiring disclosure of information in a party's possession when
 6 that party responds to interrogatories). There is no principled basis for deferring SenoRx's responses
 7 to these focused Interrogatories.

8 This is, moreover, more than just an issue of timing. SenoRx's stated position is *not* that it will
 9 answer the Interrogatories at some point in time prior to the hearing, but rather that Hologic will have
 10 to satisfy itself with the arguments made in SenoRx's Opposition. Of course, a brief prepared by
 11 SenoRx's lawyers will presumably focus on the facts and arguments favorable to SenoRx. Needless to
 12 say, Hologic's interrogatories are not intended to flush out only those issues that can favorably be
 13 presented by SenoRx. For example, if it is SenoRx's position that there are no material differences
 14 between the competing products, then that will plainly weigh into the injunction analysis (whether or
 15 not SenoRx would have acknowledged the fact in its briefing). Alternatively, if SenoRx asserts a
 16 difference between the products in a manner inconsistent with its position taken with the FDA – the
 17 subject of Hologic's Lanham Act claims – then that too is relevant to a public interest inquiry.² In
 18 short, it is plainly inappropriate for SenoRx to insist on its Opposition Brief as a substitute for a sworn
 19 discovery response. Hologic is entitled to discover all the facts and bases for SenoRx's views, whether
 20 or not SenoRx chooses to address those facts and bases within its Opposition brief, and whether or not
 21 those facts and bases support SenoRx's positions.

22 \\\n

23
 24 _____
 25 ² Other examples of information Hologic may not receive absent SenoRx's Responses include (1)
 26 adverse events or potentially negative effects of treatment discovered during ongoing clinical testing of
 27 the SenoRx device (the Contura Multi-Lumen Balloon), and (2) SenoRx comments to medical
 28 professionals disparaging Hologic's patented device (the MammoSite applicator) or contradicting
 Hologic claims about the MammoSite applicator, either of which would damage Hologic's goodwill
 and market share.

1 **IV. CONCLUSION**

2 In summary, SenoRx cannot insist on one-sided discovery. SenoRx's reneging on its
3 agreement of limited, expedited discovery prejudices Hologic because it deprives Hologic of the
4 opportunity to discover facts relating to SenoRx's invalidity and noninfringement positions, and
5 SenoRx's allegations of harm flowing from the issuance of a preliminary injunction. Hologic is
6 entitled to this discovery in preparation for the preliminary injunction hearing and its Reply to
7 SenoRx's Opposition. For all of these reasons, Hologic's Motion to Compel SenoRx's prompt and
8 complete responses to Interrogatories Nos. 1-3 should be granted.

9 Dated: March 19, 2008

HOWREY LLP

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11 By: /s/
12 Katharine L. Altemus

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14 HOWREY LLP
15 Attorneys for Plaintiffs
16 Hologic, Inc., Cytoc Corporation,
and Hologic LP
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and HOLOGIC L.P.,

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SENORX, INC.,

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AND RELATED COUNTERCLAIMS.

Case No. C08 00133 RMW (RS)

**[PROPOSED] ORDER GRANTING
PLAINTIFFS' MOTION TO COMPEL
RESPONSES TO CERTAIN
INTERROGATORIES**

This matter comes before the Court on Plaintiffs' Motion To Compel Responses To Certain Interrogatories. Upon consideration of the memoranda filed in support, the pleadings in this action, and any other evidence and argument presented orally at hearing, the Court hereby GRANTS Plaintiff's Motion To Compel Responses To Certain Interrogatories. Defendant SenoRx, Inc. is hereby

1 ordered to serve full and complete responses to Plaintiffs' Interrogatories Nos. 1-3 within 24 hours
2 from the date of this Order.

3 It is SO ORDERED.

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6 Dated: March ____, 2008

7 The Honorable Richard Seeborg
8 United States District Court Magistrate Judge
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